

REMARKS

Claims 1-4, 6-14, 16-25, 27-32, 34-37, 39-41 and 43-47 are pending in the present application. Claims 1-4, 6-14, 16-25, 27-32, 34-37, 39-41 and 43-47 have been rejected. No claims have been allowed. Claims 1, 11, 24 and 36 have been amended. Claim 10 has been canceled. No new claims have been added.

I. Improper Finality Status

The pending Office Action has been indicated as having a status of Final. In particular, the Final Office Action states, “Applicant’s amendment necessitated the new ground(s) of rejection presented in this Office action . . . See MPEP § 706.07(a).” Applicants respectfully traverse, and submit that this finality status is premature.

The pending Office Action indicates that the current grounds of rejection are new. However, MPEP § 706.07(a) states that a “second or any subsequent action on the merits shall be final, *except where the examiner introduces a new ground of rejection that is [not] necessitated by applicant’s amendment of the claims*” (emphasis added). Although several claims were amended in Applicants’ previous response, *all* claim amendments simply incorporated existing dependent claims into independent claims. No *new* claim element was added to any claim, and no new claim scope was created with respect to that which had already been presented by the originally filed claims. For example, original independent claim 1 was amended to incorporate dependent claim 5, and claim 5 was canceled accordingly. No other amendment to claim 1 was made. Accordingly, any rejection of claim 1 on new grounds could not possibly have been necessitated by Applicants’ amendment, since claim 1 merely has the exact same scope as

originally filed claim 5. Similar facts apply for every other claim that was amended in Applicants' prior response.

Because the pending rejections have been made under new grounds (new prior art), and because these new grounds for rejection were not necessitated by Applicants' amendments, Applicants respectfully request withdrawal of the current finality status for this case.

II. Claim Rejections under 35 U.S.C. § 102

Claims 11-14, 16, 18, 24-25, 27-32 and 34 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,078,265 to Bonder, et al. ("Bonder"). Applicants respectfully traverse.

In order to anticipate a claim, a reference must teach or suggest every element of that claim. Independent claim 31 is directed to and recites: "A gaming machine." Applicants respectfully submit that Bonder does not teach or suggest a gaming machine. Accordingly, Bonder cannot be said to anticipate claim 31. Because claims 32 and 34 both depend from claim 31, Bonder cannot be said to anticipate these claims as well. Applicants thus respectfully request withdrawal of the pending § 102 rejections for claims 31, 32 and 34 for at least this reason.

Independent claim 29 recites, "a locking means . . . adapted to deny access to said key accessible environment unless two separate sources of indicia *are read and confirmed by said locking means*, wherein at least one of said two separate sources of indicia includes biometric information specific to one or more users of said locking means" (emphasis added). Bonder does not teach a locking means that reads and confirms two separate sources of indicia. Rather, Bonder teaches an "intelligent key" that is adapted to read and confirm a fingerprint source of indicia. This intelligent key is separate from the "locking means" of Bonder, however, and the

present claim 29 is directed only toward a “locking means,” which is inherently separate from the actual key. Furthermore, Applicants note that claim 29 is written in “means plus function” format, meaning that this claim must be interpreted in a manner consistent with the support for such claim elements that are taught in the present specification. Accordingly, Bonder cannot be said to anticipate claim 29 for at least the foregoing reasons. Because claim 30 depends from claim 29, Bonder cannot be said to anticipate this claim either. Applicants respectfully request withdrawal of the pending § 102 rejections for claims 29 and 30 for at least these reasons.

With respect to independent claims 11 and 24, Applicants have amended these claims to more clearly distinguish the claimed subject matter over the prior art of record. In particular, claim elements for “analyzing said second source of indicia with respect to a stored biometric information file at a location separate from said key” and “an approval mechanism adapted to compare said biometric information with data stored separately from said mechanical key, wherein said approval mechanism is located separately from said mechanical key” have been added. Support for these claim elements can be found throughout the specification as originally filed, such as, for example, at paragraphs 0009, 0040, 0045-0046 and 0056-0063 of the specification as filed. Applicants respectfully submit that these claim elements distinguish over Bonder at least for the reason that Bonder teaches an “intelligent key” that reads, analyzes and validates fingerprint data by itself, with such validation not being done remotely from the key.

III. Claim Rejections under 35 U.S.C. § 103

Claims 1-3, 36-37 and 39 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,439,996 to LeMay, et al. (“LeMay”) in view of Bonder. In addition, claims 4 and 6-8 stand rejected as being unpatentable over LeMay, Bonder and further in view of

U.S. Patent No. 6,709,333 to Bradford, et al. (“Bradford”). Claims 9 stands rejected as being unpatentable over LeMay, Bonder and Bradford, in further view of U.S. Patent No. 6,374,653 to Gokcebay, et al. (“Gokcebay”). Claims 10 stands rejected as being unpatentable over LeMay in view of Bonder and Gokcebay. Claims 17 stands rejected over Bonder in view of Bonder. Claim 19 and 21-22 stands rejected over Bonder in view of Gokcebay. Claim 23 stands rejected over Bonder in view of LeMay. Claim 40 stands rejected over LeMay and Bonder and further in view of Bradford. Claims 41, 43-44 and 45-47 stand rejected over LeMay in view of U.S. Patent No. 6,945,870 to Gatto, et al. (“Gatto”) and further in view of Bonder. Applicants respectfully traverse these rejections.

To establish a *prima facie* case of obviousness, a proffered combination of prior art references must teach or suggest all of the claim limitations. *See, e.g.,* MPEP § 2143. In addition, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or combine reference teachings. *See id.* Applicants respectfully submit that these requirements are not both met in any of the obviousness rejections as set forth in the Office Action, and as such incorporate the prior remarks made in this regard from Applicants’ Response of March 29, 2006. In particular, Applicants respectfully submit that numerous non-analogous references have been combined to make many of the pending obviousness rejections, and that no proper motivation has been provided to combine all of these non-analogous references in the manner done.

Furthermore, a purported combination of references must teach or suggest every element of a claim in order for an obviousness rejection to be proper. Many of the pending claims have elements that have not been shown to be present in the recited combinations of references. For example, independent claim 41 recites, “A universal key security system, comprising: at least

one computer server.” However, no recited reference teaches “a universal key security system comprising at least one computer server,” and nothing in Bonder, Gatto or any other reference suggests that such a universal key security system should have a computer server, much less an associated database adapted to store user files, a server functionality to provide an authorization signal, or a server functionality to provide verification of user biometric information, as set forth in the claims depending from claim 41. As noted above, Bonder teaches that such functionalities are provided solely within the key itself, and Bonder does not teach or suggest a separate outside computer server or database to be used with such a reading, verification and authorization process. Applicants thus respectfully submit that *each* of claims 41 and 43-47 recite individual elements that are clearly patentably distinct over the prior art of record, and accordingly request withdrawal of the rejections for each of these claims.

Also, the pending Office Action rejects claim 10 on what appears to be the same basis of rejection for claim 9. However, claim 10 recites the additional step of “restricting access to said key accessible environment selectively based on one or more additional factors.” Not only does the Office Action fail to address this entire method step, but this method step is an original claim that has not been appropriately rejected. Applicants thus respectfully submit that claim 10 has not been properly rejected, and request withdrawal of the pending rejection of claim 10 for at least this reason. In the interests of expediting prosecution, Applicants have elected to amend independent claim 1 to incorporate claim 10, and have canceled claim 10 accordingly. In the further interests of expediting prosecution, independent claim 36 has been similarly amended to include the method step of claim 10. As a result of these amendments, it is respectfully submitted that claims 1 and 36 and all claims dependent therefrom are now allowable over the prior art of record. Applicants thus respectfully request that these claims be passed to issuance.

CONCLUSION

Applicants respectfully submit that all claims are in proper form and condition for patentability, and request a Notification of Allowance to that effect. It is believed that no fees are due at this time. Should any fee be required for any reason related to this document or application, however, then the Commissioner is hereby authorized to charge said fee to Deposit Account No.50-0388, referencing Docket No. IGT1P102. The Examiner is respectfully requested to contact the undersigned attorney at the telephone number below with any questions or concerns relating to this document or application.

Respectfully Submitted,
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